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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/599,299 | 06/21/2000 | Sarita M. James | MS1-559US | 6995 |

22801 7590 08/12/2004

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| EXAMINER |
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ZHEN, WEI Y

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2122

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,299

Applicant(s)

JAMES ET AL.

Examiner

Wei Y Zhen

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 and 64-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20, 37-46 and 71-81 is/are allowed.
- 6) ☒ Claim(s) 21-36, 47-61, 64-70 and 82-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2122

DETAILED ACTION

1. This office action is in response to the RCE filed on 7/1/2004.
2. Claims 21-36, 47-61, 64-70, 82-96 remain rejected, see the previous office action mailed on 4/20/2004 for the rejections to claims 21-36, 47-61, 64-68, 70, 82-96.
3. Claims 1-20, 37-46, 71-81 are allowed in view of applicant's amendments and arguments.
4. The rejection to claim 94 under 35 U.S.C. 112, second paragraph is withdrawn in view of applicant's amendment.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern et al. (U.S. Patent Number 6,282,711) in view of Taylor (U.S. Patent Number 5,721,824).

In regard to Claim 69, Halpern teaches: (a) identifying end user features (Figure 2, item 2B-1); (c) creating individual software packages for end user features (Figure 2, item 5); and (e) hosting the software packages on a web server (Column 1, lines 15-20).

Halpern does not teach identifying shared dependencies between the end user features and creating individual software packages for the shared dependencies. Taylor, however, does teach identifying shared dependencies between the end user features (Figure 2A, item 100) and creating individual software packages for the shared dependencies (Figure

Art Unit: 2122

3, item 12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to identify end user features, create individual software packages for end user features and host the software packages on a web server, as taught by Halpern, where shared dependencies are identified between the end user features and creating individual software packages for the shared dependencies, as taught by Taylor, since this allows software to function once it is installed without the need for additional installs.

Halpern and Talyor further do not disclose the act of identifying and acts of creating are independent of user input. However, creating software package automatically was well known in the art at the time the invention was made. Therefore, it would have been obvious to incorporate the teaching of the well known knowledge into the teachings of Halpern and Talyor to have the act of identifying and acts of creating be independent of user input because doing so provides an efficient method to create the software package automatically and free the users from the manual labors of creating the software package.

Response to Arguments

6. Applicant's arguments with regard to claims 21-36, 47-61, 64-70, 82-96 filed on 7/1/2004 have been fully considered but they are not persuasive.

Applicant has argued:

1) As per claim 82, Applicant submits that Rowley "read only" flag neither discloses nor suggests file usage statistics as that term is utilized in the claim and the Specification.

Art Unit: 2122

2) As per claim 55, there is no disclosure in either reference to provide a data structure that associates one or more first tags with file groups and one or more second tags with specific files. Rather, Rowley's manifest appears to simply list application files that make up a particular version of an application. More specifically, the parameters that are included in Rowley's manifest include a file name of an application file, a version number, a target directory, a date and time of issue, and additional information-none of which is disclosed to comprise file groups. Additionally, Iannucci simply discloses a clickable link. There is no teaching or suggestion that such link is defined by or defines both first tags indicative of associated file groups and second tags indicative of specific files that comprise a software extension.

3) As per claim 21, the Office arguing that Rowley's file groups allow users to choose file groups to download and hence, when the groups get downloaded. This logic is misplaced for at least the following reason. In Rowley, it is the user who determines when the files are downloaded. This claim specifically recites that the file groups determine when particular files of the extension get downloaded. Swank does not disclose or suggest hashes in the context of a data structure that comprises the other components recited above to assist in delivering software extensions via the Internet.

4) As per claim 47, the Office admits that Rowley does not teach that the list contains a hash for one or more of the files comprising the software extension, creating a hash for one or more received files and comparing the created hash with the corresponding file hashes to ascertain the security of the file. The Office then relies on Swank and argues that it discloses storing a hash for an individual file to be updated, creating an updated hash of a received file, and comparing the hashes to determine the

integrity of the file. Based on this, the Office argues that the subject matter of this claim would be obvious in view of these two references. Applicant disagrees.

5) As per claim 51, first, Swank is not at all directed to updating software extensions as recited in this claim. Rather, Swank appears to be directed to a non-analogous area of art. Second, Swank process relied upon by the Office is not directed to comparing hashes for newer versions of anything with older versions of anything for the purpose acquiring a newer version. Rather, Swank process is directed to comparing such hashes and, if different, possibly acquiring the older version (i.e. the old document) so that the text in the old document can be updated. The Office's attempted combination is misplaced and, at best, rests on hindsight reconstruction which has been specifically proscribed by the Federal Circuit.

6) As per claim 64, specifically, the claim recites that the download queue is defined and controls when files are to be downloaded to a client. The remainder of the claim (the recited acts of ascertaining and manipulating) are directed to ascertaining whether a user action requires one or more files that are not currently being downloaded and if so, manipulating the download queue so that one or more required files are downloaded sooner than they would otherwise be. Hence, Carpenter fails to teach queue management as recited in this claim. Specifically, Carpenter fails to teach the subject matter missing from Collins III-i.e. "ascertaining whether a user action at the client requires one or more files that are not currently being downloaded, and manipulating the download queue responsive to a user action that requires one or more files that are not currently being downloaded so that the one or more required files are downloaded sooner than they would otherwise be". Carpenter's scant teaching of user manipulation of a

Art Unit: 2122

queue falls far short of supplying this missing subject matter and a motivation to use it to modify Collins III.

7) As per claim 69, the Office admits that neither Halpern nor Taylor teach that the acts of identifying and creating are performed without user input. It is inappropriate for the Office to reject as obvious the subject matter of this claim using nothing more than a per se rule of obviousness, when such per se rules have been indicated by the Federal Circuit to be legally incorrect.

8) As per claim 86, Bailey discloses a software testing system that measures execution of machine code instruction in an executing program. It appears that Bailey is not remotely associated with or concerned with methods of providing software extensions via the Internet. Thus, to this extent, Applicant continues to maintain that Bailey is not even germane to the subject matter of this claim. The reference to Kolawa is no better. Kolawa is also directed to software testing and discloses a system and method that generates a test suite for a computer program that comprises program statements and variables including at least one input statement having one or more input variables that are grouped into code blocks and stored in a program database. The processing that Kolawa further describes makes it abundantly clear that Kolawa is neither directed to nor in any way concerned with methods of providing software extensions via the Internet. In responding to Applicant's previous arguments, the Office states that Bailey and Kolawa are introduced to teach assigning files to scenarios that describe ways a user interacts with a software application program and assigning priorities to the scenarios. The Office then states that "Collins teaches placing software packages in a queue for downloading, thus sorting the packages in an order for downloading, where this order is taught in

Art Unit: 2122

Bailey as a certain scenario priority order." Applicant respectfully submits that the Office has engaged in impermissible hindsight reconstruction which has been specifically proscribed by the Federal Circuit. Based on the substantial differences between the subject matter of the present claim and the references to Bailey and Kolawa, the Office has failed to establish a prima facie case of obviousness.

9) As per claim 91, Collins simply discloses that once a software package is scheduled for transmission via the internetwork to a target computer, group or Profile, an indication is stored in the Outbound Package Queue (13). See, column 5, lines 34-37. Collins does not disclose or suggests "sorting the multiple files based on scenario priority of one or more scenarios into which each file can be placed."

Examiner's Response:

1) In regard to Claim 82, the applicant states that the "read only" flag as taught in Rowley, is not a file usage statistic as defined in the Specification. "read only" flag is a statistic because it dictates how a tile is used. It is noted that the features upon which applicant relies (i.e., "file usage statistics from scenario runs are collected ... that will likely be used by the user first") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2) In regard to Claim 55, Rowley teaches a manifest file, which stores a list of files utilized in a software extension (Column 2, lines 24-30), and further teaches one or more file groups associated with files (column 2, lines 25-28). Rowley does not teach

Art Unit: 2122

that the individual files and file groups comprise tags indicate the individual files and tile groups. Iannucci, however, does teach a manifest file in the form of a web page, which is sent to the client for use in downloading a software extension (Column 5, lines 47-51). Typically, web pages are designed using HTML, a tag based language. Using tags to separate fields in a web page is an inherent aspect of HTML. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to build a data structure which stores a list of files utilized in a software extension and further teaches one or more file groups associated with files, as taught by Rowley, where the files and file groups are indicated by tags, which is an inherent aspect of HTML, which is obviously used to construct a web page manifest, as taught by Iannucci, since this allows the manifest file to take the form of a web page. It is noted one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3) In regard to Claim 21, Rowley teaches file groups grouping files together, and allowing users to chose file groups to download, thus choosing when certain groups get downloaded. In another word, it is the grouping of the file that determining which files gets downloaded. In addition, Swank teaches using a hash to determine changes in files to determine what to download to a client (Fig. 1 and col. 3 lines 35-45).

4) In regard to claim 47, Swank clearly discloses the transmitting (downloading) data (various types, i.e. software extension) via network (Fig. 1). Swank clearly discloses storing a hash for an individual file to be updated, creating an updated hash of a received file, and comparing the hashes to determine the integrity of the file

Art Unit: 2122

(col. 3 lines 45-51, "ensuring integrity of the process...ensuring that the original file...has not been changed...").

5) As per claim 51, Swank clearly discloses updating data (various types, i.e. software extension) and comparing the hash to determine the changes in files to determine what to download (Fig. 1 and col. 3 lines 35-51). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6) As per claim 64, Carpenter clearly teaches queue manipulation based on user input (Column 7, lines 21-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to perform a download queue method that controls when files are to be downloaded to a client, the files pertaining to a software extension, as taught by Collins, where the method further ascertains whether a user action at the client requests one or more files that are not currently being downloaded, and manipulating the download queue responsive to a user action so that one or more required files are downloaded sooner than they would otherwise be, since this allows a user to prioritize tiles that need to be downloaded while the queue is in Progress. Applicant has failed to point out the error in the motivation to combine the teaching of Collins and Carpenter. Therefore, the rejection is proper and is maintained.

Art Unit: 2122

7) Applicant's arguments with respect to claim 69 have been considered but are moot in view of the new ground(s) of rejection.

8) In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9) In regard to Claim 91, Rowley teaches sorting multiple 5les into multiple directories, where a directory is a file group (column 2, lines 25-28). Rowley does not teach sorting multiple files based on scenario priority. Collins, however, does teach sorting data packages on a queue for downloading (column 5, lines 35-37), and hence prioritizing certain packages. Neither Rowley nor Collins teaches sorting multiple 5les based on file usage order. Bailey, however, teaches sorting test scenarios in order of coverage, which is the percentage of instructions in each file that get used (Column 1, lines 22-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to sort multiple files into file groups as taught by Rowley, sort multiple files based on scenario priority, as taught by Collins, and sort multiple files based on file usage order, as taught by Bailey, so that files that get used the most, have priority over less used files. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

Art Unit: 2122

208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Allowable Subject Matter

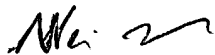
7. Claims 1-20, 37-46, 71-81 are allowed.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y Zhen whose telephone number is (703) 305-0437. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Wei Zhen
Primary Examiner
8/6/2004